UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,151	03/06/2000	Manuel Zahariev	2222.9210001	7821

26111   7590   03/06/2009
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EXAMINER
DONAGHUE, LARRY D

ART UNIT	PAPER NUMBER
2454	

MAIL DATE	DELIVERY MODE
03/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/23/2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,9,13 and 16-43* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-5,9,13,and 16-43* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

1.   Claims 1-5, 9,13, and 16-43 are presented for examination.

        35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

        Claims 13,16-18 and 34-38 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter. The claims

expressly claim software..

2.   Claims 1-5, 9,13, and 16-43 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pepe et al. (5,742,905) in view of Mizikovsy (5,559,860)

,Owens et al.(6,633,630) and Scannell et al. (5,377,354).

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3.   Pepe et al. taught the invention substantially (claim 1) as claimed, a server

(40) connected to a network; and a Mail Alert code set resident and operable on

the server, wherein the agent is adapted to compare characteristics of e-mail

messages received for the subscriber to specific message characteristics

provided by the subscriber and pre-stored on the server (col. 4, line 56- col. 5,

line 9; col. 7, line 3-15), to alert the subscriber when a characteristic match is

found, (col. 31, lines 30-65) and to execute instructions received from the

subscriber in response to the alert for forwarding of the message received for

which a match was found (col. 34, lines 59-65; col. 4, line 56-67 and fig 35-39) .

Further Pepe et al. taught that the first criteria is subject line information (col. 35,

lines 40-50).

        Though, Pepe et al. may not expressly disclose the operation of the

CallCommand to e-mail, Pepe et al. does disclose the operation, directed to

voice mail, it would have been obvious to one of ordinary skill in the art to

combine the teaching directed to wireless voice to wireless E-mail as it is

expressly suggested by Pepe et al. "Wireless technologies make subscribers

constantly available, therefore it is important to give them the ability to accept or

decline communication attempts at their discretion." Combine with the teaching of

wireless e-mail "Sending and receiving e-mail wireless messages involves two types of message flows: sending messages from the PDA 30 to the   I server 48 and from the PCI server 48 to the PDA 30."

Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message is identified by the sender, and that the end user determines the course of act to take based on the identity of the sender. Mizikovsky taught including additional identifying data in an alert with information message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-60.

Neither of the previously cited references expressly state that a criteria other than, message subject line, sender and time information, Owens et al. taught using priority as a criteria (col. 11, lines 62-67), the combined references allow for only important message from a sender to trigger an alert.

None of the previously cited references taught the characteristic being located in the e-mail message in the body or the attachment. Scannell et al. taught doing a characteristic match using keyphrase field matched against the body of the message. Scannell et al. expressly detail the advantage of the system (see col. 2, lines 44-48).

As to claim 2, Pepe et al. taught the subscriber is alerted on finding a characteristic match by sending a page to a paging device carried by the subscriber (col. 5, lines 60-67).

4.   Pepe et al. taught the invention substantially (claim 5) as claimed, an agent (40) adapted for receiving and forwarding e-mail; and a Mail Alert system adapted to compare characteristics of e-mail messages received for the subscriber to specific message characteristics provided by the subscriber and pre-stored on the server (col. 4, line 56- col. 5, line 9; col. 7, line 3-15), to alert the subscriber when a characteristic match is found (col. 31, lines 30-65), and to execute instructions received from the subscriber in response to the alert for

forwarding of the message received for which a match was found (col. 34, lines 60-65; col. 4, line 56-67 and fig 35-39. . Further Pepe et al. taught that the first criteria is subject line information (col. 35, lines 40-50).

Though, Pepe et al. may not expressly disclose the operation of the CallCommand to e-mail, Pepe et al. does disclose the operation, directed to voice mail, it would have been obvious to one of ordinary skill in the art to combine the teaching directed to wireless voice to wireless E-mail as it is expressly suggested by Pepe et al. "Wireless technologies make subscribers constantly available, therefore it is important to give them the ability to accept or decline communication attempts at their discretion." Combine with the teaching of wireless e-mail "Sending and receiving e-mail wireless messages involves two types of message flows: sending messages from the PDA 30 to the PCI server 48 and from the PCI server 48 to the PDA 30."

Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message is identified by the sender, and that the end user determines the course of act to take based on the identity of the sender. Mizikovsky taught including additional identifying data in an alert with information message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-60.

Neither of the previously cited references expressly state that a criteria other than, message subject line, sender and time information, Owens et al. taught using priority as a criteria (col. 11, lines 62-67), the combined references allow for only important message from a sender to trigger an alert.

None of the previously cited references taught the characteristic being located in the e-mail message in the body or the attachment. Scannell et al. taught doing a characteristic match using keyphrase field matched against the

body of the message. Scannell et al. expressly detail the advantage of the system (see col. 2, lines 44-48).

As to claim 9, Pepe et al. taught prerecording on a mail server characteristics for messages to be routed, the characteristics provided by a subscriber; receiving messages addressed to the subscriber at the mail server; comparing characteristics of messages received to the prerecorded characteristics provided by the subscriber (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); identifying and storing on the mail server messages received for the subscriber for which a match is found to the prerecorded characteristics (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); alerting the subscriber to the receipt of one or more messages for which a characteristic match is found (col. 4, line 56- col. 5, line 9; col. 7, line 3-15, col. 31, lines 30-65); receiving instructions for forwarding the stored messages from the subscriber in response to the alert Col. 31, lines 32-65 and col. 29, lines 42-64); and; forwarding the stored messages for which a match is found to destinations provided by the subscriber in response to the alert (col. 19, line 30- col. 20, line 25). . Further Pepe et al. taught that the first criteria is subject line information (col. 35, lines 40-50).

Though, Pepe et al. may not expressly disclose the operation of the CallCommand to e-mail, Pepe et al. does disclose the operation, directed to voice mail, it would have been obvious to one of ordinary skill in the art to combine the teaching directed to wireless voice to wireless E-mail as it is expressly suggested by Pepe et al. "Wireless technologies make subscribers constantly available, therefore it is important to give them the ability to accept or decline communication attempts at their discretion." Combine with the teaching of wireless e-mail "Sending and receiving e-mail wireless messages involves two types of message flows: sending messages from the PDA 30 to the PCI server 48 and from the PCI server 48 to the PDA 30."

Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message is identified by the sender, and that the end user determines the course of act to take based on the identity of the sender. Mizikovsky taught including additional identifying data in an alert with information message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-60.

Neither of the previously cited references expressly state that a criteria other than, message subject line, sender and time information, Owens et al. taught using priority as a criteria (col. 11, lines 62-67), the combined references allow for only important message from a sender to trigger an alert.

None of the previously cited references taught the characteristic being located in the e-mail message in the body or the attachment. Scannell et al. taught doing a characteristic match using keyphrase field matched against the body of the message. Scannell et al. expressly detail the advantage of the system (see col. 2, lines 44-48).

5.   As to claim 13, Pepe et al. taught agent for processing e-mail messages, comprising: a stored list of message characteristics provided by a subscriber; a receiver adapted for receiving e-mail messages and ascertaining message characteristics of the received messages (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); a comparator adapted for comparing characteristics of received messages with stored characteristics, and tagging those messages wherein the characteristics match (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); an alert mechanism for alerting a subscriber to the receipt of messages having characteristics matching the stored characteristics (col. 4, line 56- col. 5, line 9; col. 7, line 3-15),; and a save facility adapted for storing matched messages against future distribution instructions, the future distribution instructions received from the subscriber in response to the alert (col. 19, line 30- col. 20, line 25). .

Further Pepe et al. taught that the first criteria is subject line information (col. 35, lines 40-50).

Though, Pepe et al. may not expressly disclose the operation of the CallCommand to e-mail, Pepe et al. does disclose the operation, directed to voice mail, it would have been obvious to one of ordinary skill in the art to combine the teaching directed to wireless voice to wireless E-mail as it is expressly suggested by Pepe et al. "Wireless technologies make subscribers constantly available, therefore it is important to give them the ability to accept or decline communication attempts at their discretion." Combine with the teaching of wireless e-mail "Sending and receiving e-mail wireless messages involves two types of message flows: sending messages from the PDA 30 to the PCI server 48 and from the PCI server 48 to the PDA 30."

Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message is identified by the sender, and that the end user determines the course of act to take based on the identity of the sender. Mizikovsky taught including additional identifying data in an alert with information message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-60.

Neither of the previously cited references expressly state that a criteria other than, message subject line, sender and time information, Owens et al. taught using priority as a criteria (col. 11, lines 62-67), the combined references allow for only important message from a sender to trigger an alert.

None of the previously cited references taught the characteristic being located in the e-mail message in the body or the attachment. Scannell et al. taught doing a characteristic match using keyphrase field matched against the body of the message. Scannell et al. expressly detail the advantage of the system (see col. 2, lines 44-48).

As to claim 16, Pepe et al. taught a forwarding facility for retrieving and forwarding stored messages to destinations provided by the subscriber (col. 19, line 30- col. 20, line 25).

As to claims 4 and 17, Pepe et al. did not expressly disclose the use of the automated telephone menu for responding to the alert. Pepe et al. did disclose the use of a telephone menu (col. 11, lines 14-32) and Pepe et al. discloses the use of cross media notification and performing the redirection in real time (col. 20, line 42 - col. 21, line 53). Pepe et al. taught that the system is for operating with mobile equipment such as PDA, pager and cellular phone (col. 5, lines 56-67). It would have been obvious to one of ordinary skill in the art at the time of the invention in view of the cited teachings that an automated telephone menu for responding to the alert would have been an obvious modification, as Pepe et al. expressly disclosed that the media and format for delivery is selectable by the subscriber (col. 6, lines 1-19).

Claims 3,and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the rejection as applied above, and further in view of Fuller et al. (6,545,589).

Pepe et al. did not expressly disclose the involvement of an operator in the system, Fuller et al. taught the use of operator in a menu system to aid the user (col. 46, lines 12-30). It would have been obvious to one of ordinary skill in the data processing art at the time of the invention to allow for operator assists to aid the user in directing the calls.

Claims 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al. (5,742,905) in view of Mizikovsy (5,559,860) ,Owens et al. (6,6630,630) and Scannell et al. (5,377,354).

As to claim 19, Pepe et al. taught receiving a message for a subscriber (at least col. 29, lines 42- col. 30, line 13); comparing the message to criteria (at least col. 29, line 41- col. 30, line 13, figures 38 and 39); if the message

matches the criteria (col. 29, lines 41-46, figures 38 and 39), then sending an alert to the subscriber (col. 29, line 42- col. 30, line 13, figures 38 and 39); receiving a reply from the subscriber in response to the alert, the reply comprising instructions for the message; and processing the message according to the instructions (col. 29, line 47- col. 30, line 13, col. 31, lines 33-65)) Further Pepe et al. taught that the first criteria is subject line information (col. 35, lines 40-50).

Though, Pepe et al. may not expressly disclose the operation of the CallCommand to e-mail, Pepe et al. does disclose the operation, directed to voice mail, it would have been obvious to one of ordinary skill in the art to combine the teaching directed to wireless voice to wireless E-mail as it is expressly suggested by Pepe et al. "Wireless technologies make subscribers constantly available, therefore it is important to give them the ability to accept or decline communication attempts at their discretion." Combine with the teaching of wireless e-mail "Sending and receiving e-mail wireless messages involves two types of message flows: sending messages from the PDA 30 to the PCI server 48 and from the PCI server 48 to the PDA 30."

Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message is identified by the sender, and that the end user determines the course of act to take based on the identity of the sender. Mizikovsky taught including additional identifying data in an alert with information message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-60.

Neither of the previously cited references expressly state that a criteria other than, message subject line, sender and time information, Owens et al. taught using priority as a criteria (col. 11, lines 62-67), the combined references allow for only important message from a sender to trigger an alert.

None of the previously cited references taught the characteristic being located in the e-mail message in the body or the attachment. Scannell et al.

taught doing a characteristic match using keyphrase field matched against the
body of the message. Scannell et al. expressly detail the advantage of the
system (see col. 2, lines 44-48).

As to claim 20, Pepe et al. taught the message is an email message (col.
20, lines 13-53) .

As to claim 21, Pepe et al. taught the alert is a notification message that
identifies the received message and criteria matching the message (col. 20, lines
13-53).

As to claim 22, Pepe et al. taught the comparing step comprises filtering
the message to determine if parts of the message meet the criteria (col. 4, line
56- col. 5, line 9; col. 7, line 3-15).

As to claim 23, Pepe et al. taught the criteria are selected from the group
consisting of message sender information; message subject line information;
message body information; and message attachment information.

The claim is in the alternative, see (col. 29, line 42- col. 30, line 13, figures
38 and 39).

As to claim 24, Pepe et al. taught wherein the alert comprises at least a
portion of the message (col. 20, lines 42-57).

As to claim 25, Pepe et al. taught the alert is a message sent to a pager
(col. 23, line 63 – col. , line 13).

As to claim 26, Pepe et al. taught wherein the alert is a message sent to a
phone (32,26).

As to claim 27, Pepe et al. taught the instructions comprise a command to
forward the message to a new destination (col. 29, line 47- col. 30, line 13).

As to claim 28, Pepe et al. taught the new destination is selected from the
group consisting of an e-mail address; a fax number; a telephone number; a
hand-held computer; a notebook computer; a server computer; and an Internet

Service Provider (ISP) (col. 29, line 47-col. 30, line 13, figure 3, 22, 48, 32, 24, 34).

As to claim 29, Pepe et al. taught wherein the reply is received via an entity selected from the group consisting of an operator; a voice-response system; a telephone call; an auto attendant; and a two-way pager.

The claim is in the alternative Pepe et al. taught at least the use of a phone (32,26).

As to claims 30-33, Pepe et al. taught the use of multiple criteria (col. 35).

Claims 34-43 are rejected for similar rationale as those presented above.

Applicant's arguments with respect to claims 1-5, 9,13, and 16-43 been considered but are moot in view of the new ground(s) of rejection.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are noted on attached PTO 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D. Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Larry D Donaghue
Primary Examiner
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